

REMARKS

Specification

The specification is objected to under 37 CFR 1.75(d)(1) as failing to provide antecedent basis for the claimed subject matter since the terms “axis”, “perpendicular”, and planar surface” do not exist in the specification. Applicant traverses this objection.

Compliance with 37 CFR 1.75(d)(1) only requires that the meaning of the claims may be ascertainable by reference to the description. See MPEP 2163.01, ¶3; *Lampi Corp. v. American Power Prods., Inc.*, 56 U.S.P.Q.2d 1445, 1455 (Fed. Cir. 2000) (“In order to satisfy the written description requirement, the disclosure as originally filed need not provide *in haec verba* [‘in these words’] support for the claimed matter at issue.”). Even if the exact words “axis”, “perpendicular”, and planar surface” do not appear in the specification, a person of ordinary skill in the art would understand the meaning of these terms with reference to the description. For example, it would be apparent from the drawings and specification that the mouse pad surface referenced at page 13, line 5 of the specification would be a planar surface. Likewise, the meaning of the terms “axis” and “perpendicular” would be apparent to a person of ordinary skill in the art with reference to the specification and drawings.

Claim Rejections – 35 USC §103

Claims 1-8, 10-12, 14, 18-20, 22-24 and 26 stand rejected under 35 USC §103(a) as being unpatentable over Japanese Patent Application Laid-Open No. P2001-15994A to Shimono in view of U.S. Patent Application Publication No. 2002/0036621 to Liu, et al. Applicant traverses this rejection.

Claim 1 recite that the source loop solenoid has an axis substantially perpendicular to the planar surface of the base unit. In contrast, Liu’s solenoid has an axis that runs circumferentially around the periphery of a pad, and thus the axis is parallel to the planar surface of the pad, rather than perpendicular as recited in claim 1. Therefore, Liu cannot serve as the basis for an obviousness rejection of claim 1.

In the Final Office Action, the Examiner argued that Liu discloses a solenoid having an axis parallel *and* perpendicular to the planar surface, with specific reference to Fig. 1 and paragraph [0032] of Liu. This argument, however, appears to be based on an incorrect reading of Liu. Paragraph [0031] of Liu relates a coil in a *touch stimulating device* rather than a base unit as recite in claim 1. Although paragraph [0032] mentions at “base,” this refers to the base of the touch stimulating device, not a base unit as that term is used in claim 1.

Moreover, the Examiner notes that Liu mentions an antenna that may have “any sort of axis” in paragraph [0032]. In essence, the Examiner is arguing that it would have been obvious to try orienting a solenoid in any direction. “Obvious to try”, however, is not the standard for obviousness under 35 USC §103. A determination that something is obvious under Section 103 has been held to be error where what would have been obvious to try would have been to try each of numerous different possible choices where the prior art gave no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful, or to explore a new technology or general approach that seemed to be a promising field of experimentation, but where the prior art only gave general guidance as to the particular form of the claimed invention or how to achieve it. *In re O’Farrell*, 7 USPQ2d 1673, 1681 (CAFC 1988).

Liu’s use of phrases such as “any sort of axis” in paragraph [0032] and “any other configuration” in paragraph [0030] provides no specific guidance and provides no direction as to which specific configuration is likely to be successful. For at least this reason, a *prima facie* case of obviousness has not been established with respect to claim 1. Claims 14, 23 and 27 also recite similar limitations relating to an axis arranged perpendicular to the planar surface. Therefore, Liu cannot serve as the basis for an obviousness rejection of claims 14, 23 and 27.

Claims 2-13, 15-22, 24-26 and 28-30 are rejected under 35 USC §103(a) based on various combinations of references cited by the Examiner, all of which include Liu. For at least this reason, a *prima facie* case of obviousness has not been established with respect to claims 2-13, 15-22, 24-26 and 28-30, since all of these rejections are based on the same incorrect interpretation of Liu as discussed above.

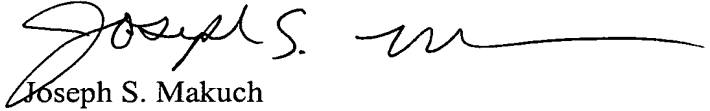
Conclusion

Applicant requests reconsideration in view of the foregoing amendments and remarks. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

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Respectfully submitted,

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